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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/772,810	01/30/2001	Bart Victor	3977-8	1008

7590 10/21/2003
PITNEY, HARDIN, KIPP & SZUCH LLP
711 Third Avenue
New York, NY 10017-4059

EXAMINER

FERNSTROM, KURT

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 10/21/2003

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TECHNOLOGY CENTER R3700

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/772,810

Applicant(s)

VICTOR ET AL.

Examiner

Kurt Fernstrom

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8-11, 13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 8-11, 13 and 14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

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DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 1-6, 8-11 and 13-14 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The claims are directed towards a method of fostering thinking, comprising performing various steps in an attempt to enhance or facilitate discussion concerning the thoughts of various participants of a meeting, which is not patentable subject matter.

The Federal Circuit has applied the practical application test to determine whether claimed subject matter is patentable under 35 USC 101. *ATT Corp. V. Excel Communications, Inc.*, 172 F.3d 1352, 1359-60, 50 USPQ2d 1447, 1452-53 (Fed. Cir. 1999); *State Street Bank & Trust Co. V. Signature Financial Group Inc.*, 149 F.3d 1368, 1373, 47 USPQ2d 1596, 1600 (Fed. Cir. 1998). The test for practical application requires that a “useful, concrete and tangible result” be accomplished. The present invention does not meet the test, that is; it does not produce a result which is concrete or tangible. The thoughts of a person are subjective and indefinite, and not tangible or concrete. While the physical models being created as part of the method are themselves “tangible” and “concrete”, the test for determining patentability concerns whether the results of a method are tangible and concrete.

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Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-6, 8-11 and 13-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Because the invention does not produce a concrete or tangible result for the reasons discussed above, the invention cannot operate as intended without undue experimentation.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-6, 8-11 and 13-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims contain several examples of language which is overly vague and broad, such that the scope of the invention is defined with sufficient particularity. For example, it is not clear how the invention is defined by such phrases as “to serve as physical metaphors” (claim 1), “relating to aspects of the topic” and “how the features of the

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model relate to the topic” (claim 1), “involves” and “business planning” (claim 2), “represents” and “an aspect” (claim 3), “how that relates to how the company and its customer interact” (claim 4), “how to address changes in how the company and its customer interact” (claims 5, 6 and 14) and “representing guiding principles” (claim 14).

Response to Arguments

7. Applicant's arguments filed on August 1, 2003 have been fully considered but they are not persuasive. While the physical models of building blocks which are created do in some sense create a “concrete” and “tangible” result, the models are considered to be the result of a creative expression by the user, and do not have patentable utility. The ability of a user to represent metaphors using the physical models, and the step of discussing the meaning of the models, does not suffice to impart utility to the models under 35 USC 101. Rather, the models of the claimed invention are analogous to a work of art, which allows the user to represent certain themes and present an item for inspiring philosophical discussion. So, while the building block models of the claimed invention might be “useful” in some sense of the term, they are not “useful” in the manner required by 35 USC 101 for patentability.

The rejections under 35 USC 112, para.1, are maintained for similar reasons. While it is known how to create models using building blocks in a broad sense, the specification does not enable one to know how to create models which meet the limitations of the claims, by serving as metaphors relating to aspects of a business topic. Because the models are essentially creative

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expressions, formed by the imagination of the user, the specification inherently cannot enable one to know how to create the specific models of the invention. The standards in determining whether a physical model serves as a metaphor, or represents some aspect of a selected topic, are subjective and indeterminate. The method does not yield reliable, repeatable results, because each user of the method will naturally arrive at a different subjective interpretation of how to construct the model. This is particularly true for some of the dependent claims, including by way of example claims 5, 6 and 13. Discussions and stories are inherently subjective and indeterminate; and cannot be enabled in such a way as to enable one to know how to perform the method to arrive at the desired result.

The arguments concerning the rejections under 35 USC 112, para. 2, are also unpersuasive. While the specification provides some guidance as to what is meant by the disputed claim terminology by way of providing examples, such examples do not sufficiently define the scope of the claims. One of ordinary skill in the art may have some general sense of what may be meant by the claim terminology; however, the terminology used in the claims is so broad as to make it unclear what other examples may fall within the claimed invention, or what is considered to fall outside the scope of the invention. Because the concepts being modeled are largely abstract entities, it is not clear what structural limitations are encompassed by a physical model “representing” some abstract concept such as a, “aspect” of a topic or a “guiding principle”. It is agreed that the term “represents” in claims 3 and 9 is definite, as it is clear how a model of building blocks would represent a tangible entity such as a customer or a person. That particular

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rejection has been withdrawn; the rejection of “represents” in claim 3 refers to that use of the term pertaining to “an aspect of the company”.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303.

KF

October 17, 2003

Kurt Felt
Kurt Fernstrom